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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,983	08/13/2001	Barry J. Gilhuly	1400-1072 P6	8317

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RESEARCH IN MOTION
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EXAMINER

STRANGE, AARON N

ART UNIT	PAPER NUMBER
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2153

MAIL DATE	DELIVERY MODE
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05/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/928,983	Applicant(s) GILHULY ET AL.	
	Examiner AARON STRANGE	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 175-225 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 175-225 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Examiner would like to note that the present application has been reassigned to a new Examiner.

Priority

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed applications, International Patent Application No. PCT/CA00/01108 (filed Sep. 25, 2000), U.S. Patent Application No. 09/401,868 (filed Sep. 23, 1999), and U.S. Patent Application No. 09/087,623 (filed May 29, 1998), each fail to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The prior filed application fail to provide support for the particular key exchange encryption method appearing in each claim of the present application. Accordingly the effective filing date

for each of the pending claims is deemed to be the filing date of the present application, Aug. 13, 2001.

In the event Applicant disagrees with these findings, Applicant should specifically point out the locations in the prior application(s) where support for the claimed encryption method may be found.

Response to Arguments

3. Applicant has cancelled all previously presented claims necessitating a new rationale for the rejection. Although Applicant's arguments have been considered and the cited references remain the same, the rationale of the rejection has been modified in view of the newly presented claims. The rejection set forth below is believed to clearly set forth the position of the Office. Further discussion of Applicant's arguments beyond the rejection set forth below would be unnecessarily duplicative, and has been omitted.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification fails to provide antecedent basis for the term "computer-accessible medium", appearing in claims 209-225. The specification and/or claims should be amended to ensure that the specification provides adequate antecedent basis for the claim terminology, taking care to ensure that no new matter is introduced.

Claim Objections

5. Claim 192 is objected to because of the following informalities: There appears to be a typographical error “A system ... comprising the steps of” (emphasis added) in lined 1-3. Appropriate correction is required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 192-208 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. Claims 192-208 are directed to a “system” comprising a plurality of “means for” performing various functions. The specification of the present application discloses that these functions are performed by the redirector program. Since the redirector program is a software program, the disclosure would have suggested to one of ordinary skill in the art that the claimed means are intended to include software-only embodiments. Since the claim is not limited to non-statutory subject matter, it is non-statutory.

Additionally, it is noted that claimed 209-225 contain limitations directed to a “code portion for” performing the same functionality as the means claimed in claims 192-208. When considered in combination with the language of claims 192-208 and the

content of the specification, these provide further evince that the claimed means are intended to include software per se.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 209-225 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. With regard to claim 209, the preamble refers to a computer-accessible medium "having a sequence of instructions", comprising a plurality of "code portions". It is unclear if the claimed "code portions" are intended to equate to the recited "sequence of instructions" or are a different portion of the medium. Since it appears that the "code portions" are intended to be the instructions, they have been interpreted as such. However, the claim should be amended to use consistent terminology throughout.

12. All claims not individually rejected are rejected by virtue of their dependency from the above claims.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 175, 178, 179, 182, 183, 192, 195, 196, 199, 200, 209, 212, 213, 216 and 217 rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile ("AirMobile Software of Lotus cc:Mail Wireless: Communication Server Guide") in view of Gehrmann et al. (WO 00/31931).

15. With regard to claim 175, AirMobile discloses a method of redirecting data items from a messaging host system to a user's mobile device, comprising the steps of:

establishing a secure communications link between a redirector host system and the user's mobile device (AirMobile provides a secure and authenticated channel between the server and the mobile device)(p. 25);

detecting a new data item for the user at the messaging host system (cc:Mail Post Office server) by the redirector host system (AirMobile Wireless for cc:Mail server) (new messages are received at the post office server, and detected by the AirMobile server)(pp. 25-26);

receiving a copy of the new data item at the redirector host system (new mail item is received at the AirMobile server prior to being forwarded)(p. 26);

determining whether the new data item should be redirected from the redirector host system to the user's mobile device (AirMobile server checks download filters to determine whether to forward the message to the mobile device)(p. 26);

if the new data item should be redirected; and

transmitting the new data item from the redirector host system to the user's mobile device (messages passing the download filters will be sent to the wireless device)(p. 26).

While AirMobile teaches the use of a "secure and authenticated" channel (p. 25), it fails to specifically disclose that encrypting the messages prior to transmitting them via the channel using encryption/decryption keys generated by the redirector host system and forwarding the decryption key to the mobile device using the secure channel.

Gehrmann discloses a similar system for redirecting selected electronic messages to a mobile device (Abstract). Gehrmann teaches a redirector host system (e-mail gateway)(fig. 1, elements 24-30; p. 10, ll. 19-19-21) generating and storing a first encryption key (K_s) (p. 8, ll. 7-10; p. 9, ll. 3-8), generating a first decryption key (K_s is also used for decryption)(p. 8, ll. 26-28), and forwarding the decryption key to the user's mobile device (user A [gateway] encrypts K_s and sends it to user B [the client])(p. 8, ll. 10-12 and 15-17). Gehrmann further discloses encrypting the message with the generated key, K_s (p. 8, ll. 8-10). This would have been an advantageous addition to the system disclosed by AirMobile since it would have protected the messages from interception during transmission to the client.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to encrypt the redirected messages prior to transmission to ensure that they were not intercepted by unauthorized recipients during transmission to the client.

16. With regard to claim 178, Gehrmann further discloses that the steps of generating a first encryption key at the redirector host system and generating a first decryption key at the redirector host system further comprise generating a shared key (K_s is a shared key)(p. 8, ll. 7-28).

17. With regard to claim 179, Gehrmann further discloses that the first encryption key and the first decryption key are generated according to a symmetric key encryption scheme (K_s is a symmetric key used for both encryption and decryption)(p. 7, ll. 14-16; p. 8, ll. 7-28).

18. With regard to claim 182, Gehrmann further discloses receiving the encrypted new data item at the user's mobile device (p. 8, ll. 17-19); and
decrypting the encrypted new data item to recover the new data item using a cipher algorithm and the first decryption key (p. 8, ll. 26-28).

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19. With regard to claim 183, Gehrmann further discloses storing the new data item within a memory of the user's mobile device (a message that is "obtained" is inherently stored in a memory of the device)(p. 8, ll. 27-28).

20. Claims 192, 195, 196, 199, 200, 209, 212, 213, 216 and 217 are rejected under the same rationale as claims 175, 178, 179, 182 and 183, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

21. Claims 176, 193 and 210 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile ("AirMobile Software of Lotus cc:Mail Wireless: Communication Server Guide") in view of Gehrmann et al. (WO 00/31931) further in view of Official Notice.

22. With regard to claim 176, while the system disclosed by AirMobile and Gehrmann shows substantial features of the claimed invention (discussed above), it fails to disclose establishing a serial connection between the redirector host system and the user's mobile device as the secure communications link.

The Examiner takes Official Notice that serial connections for transferring data between two computers were old and well known in the art at the time the invention was made. Gerhmann discloses that the mobile device may be connected to the network via

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a wireless connection "or any other appropriate" connection (p. 5, ll. 26-28). One of ordinary skill in the art would have been aware of serial connections and would have recognized that a serial connection could have been used as the connection means, for example, when the mobile device is currently stored in a docking station.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a serial connection between the redirector host system and the user's mobile device, since serial connections, when available, are typically less expensive and more secure than wireless connections.

23. Claims 193 and 210 are rejected under the same rationale as claim 176, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

24. Claims 177, 194 and 211 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile ("AirMobile Software of Lotus cc:Mail Wireless: Communication Server Guide") in view of Gehrmann et al. (WO 00/31931) further in view of Mansour et al. (US 2005/0278641).

25. With regard to claim 177, while the system disclosed by AirMobile and Gehrmann shows substantial features of the claimed invention (discussed above), it fails to

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disclose that establishing the secure communications link comprises using Internet Message Access Protocol (IMAP) over Secure Sockets Layer (SSL) protocol.

Mansour teaches that IMAP over SSL allows communications between a server and a client to be "fully encrypted" (§29). Since AirMobile and Gehrman use encryption to protect messages in transmission, and IMAP over SSL is a known encryption method, the use of IMAP over SSL in the combined system of AirMobile and Gehrman would have been nothing more than a predictable variation of the encryption methods used by that system.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the well known IMAP over SSL protocol to "fully encrypt" messages transmitted between a server and a client.

26. Claims 194 and 211 are rejected under the same rationale as claim 177, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

27. Claims 180, 181, 184-190, 197, 198, 201-207, 214, 315 and 218-224 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile ("AirMobile Software of Lotus cc:Mail Wireless: Communication Server Guide") in view of Gehrman et al. (WO 00/31931) further in view of Doonan et al. (US 6,807,277).

28. With regard to claims 180 and 181, while the system disclosed by AirMobile and Gehrmann shows substantial features of the claimed invention (discussed above), it fails to disclose that the encryption key and decryption key are public and private keys, respectively.

Doonan discloses a similar system for transmitting encrypted messages via a network (Abstract). Doonan teaches using public/private asymmetric encryption keys as an alternative to symmetric encryption keys, and discloses that several asymmetric encryption algorithms are well known (col. 9, ll. 54-61). One of ordinary skill in the art would have recognized that symmetric key encryption and asymmetric key encryption were predictable variations of one another, and would have selected one or the other based on the security needs and capabilities of the system.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use asymmetric public/private key encryption as an alternative to symmetric key encryption.

29. With regard to claim 184, while the system disclosed by Airmobile and Gehrmann shows substantial features of the claimed invention (discussed above), it fails to disclose generating second encryption/decryption keys at the redirector host system and forwarding the second encryption key to the mobile device.

Doonan discloses a similar system for transmitting encrypted messages via a network (Abstract). Doonan teaches generation of encryption/decryption keys and storage of a decryption key at a server (col. 3, ll. 4-7; col. 5, ll. 4-5). Doonan further

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teaches forwarding the encryption key to the requestor (col. 5, ll. 10-13), which uses the key to encrypt a message for transmission via the network. This would have been an advantageous addition to the system disclosed by AirMobile and Gehrmann since it would have allowed the mobile devices to obtain encryption keys without being required to generate them locally. This would have reduced the amount of software and computing power needed at the mobile device by generating and managing the keys at the redirector rather than at the mobile devices.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the mobile devices acquire encryption keys from the redirection server rather than generate them locally, reducing the amount of computing power and software needed by the mobile devices.

30. With regard to claims 185 and 186, Doonan further discloses that the encryption/decryption keys are a shared key generated in accordance with a symmetric key encryption scheme (col. 3, ll. 61-54; col. 9, ll. 48-53).

31. With regard to claims 187 and 188, Doonan further discloses that the encryption/decryption keys may be public/private keys (RSA is a public/private key encryption algorithm)(col. 9, ll. 54-61).

32. With regard to claim 189-190, AirMobile and Gehrmann both teach that the mobile user can also transmit encrypted messages back to the network (AirMobile: p.

26-27)(Gehrmann: p. 9, ll. 19-20). When considered in combination with the above noted teachings of Doonan, the combined references teach and/or suggest a system that system would encrypt any messages sent in reply to a related message, transmit those replies back to the redirection server, decrypt the message and send it to the messaging host.

33. Claims 197, 198, 201-207, 214, 315 and 218-224 are rejected under the same rationale as claims 180, 181 and 184-190, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

34. Claims 191, 208 and 225 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile ("AirMobile Software of Lotus cc:Mail Wireless: Communication Server Guide") in view of Gehrmann et al. (WO 00/31931) further in view of Doonan et al. (US 6,807,277) further in view of ARDIS ("ARDIS Begins Shipping New Lan-Based E-Mail Software; First Wireless Data Network to Offer Solution for Microsoft Mail and Lotusr (sic) cc:Mail Applciaitons; Supports New Motorola Envoy 150 Wireless Communicator").

35. With regard to claim 191, while the system disclosed by AirMobile, Gehrmann and Doonan shows substantial features of the claimed invention (discussed above), it fails to specifically disclose that reply messages created at either the messaging host

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system or the mobile device share an electronic address as an originating address (i.e., the "from" address is the same whether the reply was created at the messaging host or the mobile device).

ARDIS discloses a publicly available software application called "Mail on the Run!", and further discloses that the software permitted a user of a mobile device to "wirelessly send, receive, store, forward and reply to messages on their corporate e-mail systems, retaining their LAN mailbox and ID" (p. 2, ¶1). This disclosure would have taught and/or suggested one of ordinary skill in the art to permit e-mail users to reply to messages from a mobile device in the same manner as though they had replied to the message from any other device in their "standard e-mail systems". "[R]etaining their LAN mailbox and ID" would have included using the same "from" address for the message, regardless of the device on which it was created.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the same originating address for a reply data item, regardless of the device on which the message was created since it would have allowed e-mail users to transparently access and use their e-mail from any device attached to the network.

36. Claims 208 and 225 are rejected under the same rationale as claims 191, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

Conclusion

37. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Glenton B. Burgess/
Supervisory Patent Examiner, Art Unit 2153

/A. S./
Examiner, Art Unit 2153